

REMARKS

Reconsideration and withdrawal of the rejections of the claimed invention is respectfully requested in view of the amendments, remarks and enclosures herewith, which place the application in condition for allowance.

I. STATUS OF CLAIMS AND FORMAL MATTERS

Claims 1-6 and 21-27 are now pending in this application. The claims have been amended to require at least two chiral centers, i.e. 1R and 2S. Support for the element "provided that R¹, R² and R³ are structurally different or provided that at least two of R¹, R² and R³ are structurally identical" can be found throughout the specification, see, e.g. paragraphs [0088], [0108], [0125], [0143], [0181], [0208]. No new matter has been added by this amendment.

It is submitted that the claims, herewith and as originally presented, are patentably distinct over the prior art cited in the Office Action, and that these claims were in full compliance with the requirements of 35 U.S.C. § 112.

II. THE 35 U.S.C. 103(a) REJECTION HAS BEEN OVERCOME

- A. Claims 1-6 and 11-20 were rejected as allegedly being obvious by Saito et al. (EP 0 864 567 -"Saito"). The applicants request reconsideration of this rejection for the following reasons.
- B. Claims 1-6 and 11-20 were rejected as allegedly being obvious by Lorenz et al. (WO 97/31904 -"Lorenz"). The applicants request reconsideration of this rejection for the following reasons.

The applicants maintain their positions with regard to the patentability of compounds with a single chiral center. However, in order to expedite prosecution, the applicants have amended the claims such that the compounds of the invention must have 1(R), 2(S) stereochemistry. Moreover, with regards to claims 23-25 and 27, these compounds have a third center with specific stereochemistry, i.e. the 1* position.

As noted in MPEP 2106, when evaluating the scope of a claim, every limitation in the claim must be considered. USPTO personnel may not dissect a claimed invention into discrete elements and then evaluate the elements in isolation. Instead, the claim as a whole must be considered. See, e.g., *Diamond v. Diehr*, 450 U.S. 175, 188-89, 209 USPQ 1, 9 (1981).

The claims as amended relates to substituted amino-1,3,5-triazines N-substituted with chiral bicyclic radical, specifically a radical with 1(R), 2(S) stereochemistry.

However, the rejection based on Saito appears to assume that one of ordinary skill in the art would have been directed specifically to the chiral centers in the applicants' claimed compounds. Not only is this not true, but this analysis fails to consider the vast number of Markush groups which define the variables used in the compounds of Saito.

As cited in the recent "Examination Guidelines Update: Developments in the Obviousness Inquiry After *KSR v. Teleflex*" from the Federal Register (9/1/2010 – vol. 75, no. 169), "an obvious to try rationale may be proper when the possible options for solving a problem were known and finite. However, if the possible options were not either known or finite, then an obvious to try rationale cannot be used to support a conclusion of obviousness." *Rolls-Royce PLC v. United Technologies Corp.*, 603 F.3d 1325 (Fed. Cir. 2010).

As applied here, one of ordinary skill in the art would be faced with a virtually infinite number of possible combinations of stereochemistries for the compounds of Saito and one of ordinary skill in the art would have found the applicants claimed stereochemistry for 1(R), 2(S) to have been obvious and even less so for the specific stereochemistry for 1(R), 2(S) and 1* as represented by claims 23-25 and 27.

Therefore, the applicants' claimed invention is unobvious over Saito or Lorenz.

III. THE OBVIOUSNESS-TYPE DOUBLE PATENTING REJECTION HAS BEEN OVERCOME

Claims 1-6 and 11-20 have been provisionally rejected under obviousness-type double patenting over claims 1-20 of co-pending application no. 11/733,337 ("the '337 application"). The applicants note that the '337 application was filed after the present application and as such the claims from the present invention can be allowed over the claims of the '337 application without a terminal disclaimer in the present application.

The applicants also argue that the claims of the '337 application would not represent an obvious variant of the presently claimed invention. For example, the 6-position of the triazine ring on the compounds of the '337 application requires a –CHF₂ moiety while there is no such limitation on the presently claimed compounds.

Moreover, now pending claims 1-6 and 21-27 all require at least the specific stereochemistry, 1(R), 2(S) linker which is not required by the '337 application. In addition, new claims 23-25 and 27 also require a third chiral center (the 1* position) which also not described by the claims of the '337 application.

CONCLUSION

In view of the remarks and amendments herewith, the application is believed to be in condition for allowance. Favorable reconsideration of the application and prompt issuance of a Notice of Allowance are earnestly solicited. The undersigned looks forward to hearing favorably from the Examiner at an early date, and, the Examiner is invited to telephonically contact the undersigned to advance prosecution.

Respectfully submitted,
FROMMER LAWRENCE & HAUG LLP

By: /Howard C. Lee/
Marilyn M. Brogan Howard C. Lee
Reg. No. 31,223 Reg. No. 48,104
Telephone: (212) 588-0800
Facsimile: (212) 588-0500